

REMARKS/ARGUMENTS

Upon entry of the above amendment, claim 29 will have been amended to eliminate a minor language informality and is submitted for consideration by the Examiner. Thus, claims 24-32 remain pending for consideration by the Examiner.

In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 24-26, and 30 under 35 U.S.C § 102 (e) as being anticipated by TAKAHASHI (JP 10-374412). The Examiner also has rejected claims 27-28 and 31 under 35 U.S.C § 102 (b) as being anticipated by MERCHANT et al. (U.S. Patent 5,581,366). Further, the Examiner has rejected claims 29 and 32 under 35 U.S.C § 103 (a) as being unpatentable by MERCHANT et al in view of HOCHMEN (U.S. Patent 5,838,685).

As noted above, Applicants have amended claim 29. Thus, claims 24-32 remain pending for consideration. Applicants respectfully traverse the above rejections based on pending claims 24-32 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicants' claims 24-26 relate to a server apparatus connected with a transmitting facsimile apparatus and a receiving facsimile apparatus via the Internet. The server apparatus stores reception capabilities regarding a type of facsimile data that the receiving facsimile can receive. The reception capabilities is distinct from the facsimile data. The server apparatus receives facsimile data from the transmitting facsimile apparatus, transforms the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the stored reception capabilities of the receiving facsimile apparatus, and transmits the transformed facsimile data to the receiving facsimile apparatus. Claim 30 recites a related method.

Regarding the rejection of claims 24-26 and 30 under 35 U.S.C. § 102 (e), Applicants note that the TAKAHASHI reference was published as a Japanese Patent Publication on July 14, 2000. However, since the TAKAHASHI reference is Japanese patent publication, the TAKAHASHI reference was not filed in the United States. Accordingly, the TAKAHASHI was neither published under 35 U.S.C. § 122 (b) nor issued as a U.S. patent. On the other hand, 35 U.S.C. § 102 (e) specifies "the invention was described in – (1) an application for patent, published under section 122 (b), by another filed in the United States before the invention by the application for patent or (b) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent". In other words, 102 (e) does not serve to qualify any published foreign patent document as a reference, but refers to and requires an application filed and a publication of a patent or application in the United States.

It is further noted that the present application is based on and enjoys the effective filing date of JP 11-15760 which was filed on January 25, 1999, which is before the Japanese publication date of the TAKAHASHI reference relied on by the Examiner. Thus, TAKAHASHI is also not a proper prior art under 35 U.S.C. § 102 (a) or (b).

Thus, Applicant submits that the TAKAHASHI reference is an inappropriate basis for the rejection of any of the claims in the present application. Therefore, it is respectfully submitted that the pending claims 24-26 and 30 are patentable over the Examiner's asserted reference, since TAKAHASHI is an inappropriate reference.

Regarding the rejection of claims 27-28 and 31 under 35 U.S.C. § 102 (b) as being anticipated by MERCHANT et al., Applicants' claims 27-28 and 31 also relates to a server apparatus that is configured to transmit and receive an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus.

In direct contrast, MERCHANT et al. relate to a selective call receiver having a pen input capable display screen for inputting a message by pen stylus to be transmitted by facsimile. However, the pending claims 27-28 and 31 relate to a server apparatus.

In this regard, the Examiner refers to col.4, lines 1-28 in the Outstanding Official Action mailed on February 22, 2005. This portion (col.4, lines 1-28) of the disclosure appears to relate to Fig.5 which illustrates the decoder/controller 68

and to Fig.6 which discloses a fax message form. However, the decoder/controller 68 is a component of the fax SCR 12. The fax SCR 12 has fax originate and fax receive capabilities (col.3, lines 15-17). Thus, the portion (col.4, lines 1-28) cited by the Examiner does not relate to a server apparatus, but to a transmitting facsimile apparatus or a receiving facsimile apparatus. Moreover, the reference, at col.4, lines 26-27, refers to storage of a "template", but does not refer to storage of reception capabilities of a receiving facsimile apparatus. Therefore, the cited portion does not contain any disclosures about a sever apparatus, as recitation claims 27, 28, and 31.

Further, the term "fax reception capabilities" appears in the cited portion (col.4, line 20). However, this merely describes the fax message form 100, as illustrated in Fig.6. The fax message form comprises a message box 102, a pager pin number block 104, and a heading portion 106. The pager pin number block 104 includes bubbles for spelling out a numeric code (a pager ID). The numeric code corresponds to an address of a particular fax SCR having "fax reception capabilities". On the other hand, the pending claims do not relate to inputting a pager ID. The pending claims utilize an e-mail with a predetermined address for storing the reception capabilities of the facsimile apparatus in the memory of the server apparatus, and the e-mail with the predetermined address indicates the reception capabilities of the facsimile apparatus to be stored in the memory of the server apparatus. Thus, the portion cited by the Examiner does not contain any disclosure relevant to the features of the pending claims.

The Examiner also cites col.5, line 48-col.6, line 5 in the outstanding Official Action mailed on February 22, 2005. However, the cited portion relates to the selective call receiver (SCR) 12. In other words, the cited portion describes operations performed in the SCR 12. For example, the receiver 66, the decoder/controller 68, the CPU 410, and the input/output (I/O) 412, etc., are components of the SCR 12. The fax SCR 12 has fax originate and fax receive capabilities (col.3, lines 15-17), as explained above. Thus, the cited portion does not contain any disclosure about a server apparatus.

The Examiner also cites col.5, lines 37-47 in the outstanding Official Action mailed on February 22, 2005. This portion relates to the selective call terminal 28 and the selective call receiver 40. Regarding the selective call terminal 28, it merely receives the fax message and broadcasts the fax message. Thus, the cited portion does not contain any disclosure about the features of the pending claims. On the other hand, regarding the selective call receiver 40, it has fax originate and fax receive capabilities (col.3, lines 15-17). Thus, the selective call receiver 40 does not correspond to the server apparatus, as recited in the pending claims. Therefore, the cited portion does not contain any disclosure about the features of the pending claims.

As discussed above, pending claims 27-28 and 31 are clearly distinguished over MERCHANT et al.

Therefore, it is respectfully submitted that the features recited in Applicants' claims 27-28 and 31 are not taught in or rendered obvious by MERCHANT et al. cited by the Examiner.

Regarding the rejection of claims 29 and 32 under 35 U.S.C. § 103 (a) as being unpatentable over MERCHANT et al. in view of HOCHMAN, Applicant's claims 29 and 32 relate to an Internet facsimile that transmit and receive an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the server apparatus.

In contrast to the features of claim 29 and 32, MERCHANT et al. generates a fax message on the display screen of the fax SCR 12, converts the generated fax message into an electronic fax message form, and transmits it to another fax SCR 40. However, MERCHANT et al. do not disclose a device which transmits, to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive, since MERCHANT et al. merely transmits a fax message to another fax SCR 40.

On the other hand, pending claims 29 and 32 recite an apparatus that communicates with a server and transmits, to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive. Further, the transmitted e-mail has a predetermined address and indicates the reception capabilities of the Internet facsimile apparatus to be stored in the server. MERCHANT et al. do not disclose transmission of the e-mail as recited in the pending claims. Thus, pending claims 29 and 32 are clearly distinguished over MERCAHNT et al.

Therefore, It is respectfully submitted that the combination of features recited in Applicants' claims 29 and 32 are not taught in MERCHANT et al. cited by the Examiner.

HOCHMAN relates to a method and apparatus for transmission of data files over a network. In HOCHMAN, a sender constructs an e-mail message and transmits the e-mail message through a network. A reception facility receives and stores the e-mail message. A recipient retrieves the e-mail message from the reception facility. However, HOCHMAN does not disclose a device which transmits, to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive. In other words, HOCHMAN merely teaches that the sender transmits an e-mail message to a recipient via a reception facility.

On the other hand, pending claims 29 and 32 recite a controller that is configured to transmit, to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive. Further, the transmitted e-mail has a predetermined address and indicates the reception capabilities of the Internet facsimile apparatus to be stored in the server. HOCHMAN does not disclose any features recited in the pending claims. Thus, the pending claims 29 and 32 are clearly distinguished over HOCHMAN.

Therefore, it is respectfully submitted that the features recited in Applicants' claims 29 and 32 are also not rendered obvious in MERCHANT et al. in combination with HOCHMAN cited by the Examiner, at least since HOCHMAN does not supply the shortcomings of MERCHANT et al.

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Accordingly, for each of these reasons, and certainly for all of these reasons, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

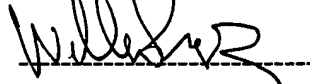
Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended a claim (by inserting a comma) for further consideration by the Examiner. With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the pending claims with the disclosures of the cited references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The amendment to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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